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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/675,358  
Filing Date: September 30, 2003  
Appellant(s): KARAOGUZ ET AL.

\_\_\_\_\_  
Joseph M. Butscher  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 06 October 2009 appealing from the Office action mailed 28 May 2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,813,775	FINSETH et al.	11-2004
6,774,926	ELLIS et al.	08-2004
7,065,778	LU	7,065,778

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-15, 24, and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finseth et al. (US 6,813,775) in view of Ellis (US 6,774,926).

Regarding claim 1, Finseth teaches accepting from a first user information identifying at least a second user, i.e. the ability of a 1<sup>st</sup> user to designate a 2<sup>nd</sup> user to which viewer preference profiles may be sent (Fig.7 & 9; Abstract; col.1, lines 44-46; col.2, lines 6-7; col.12, lines 24-28; col.15, lines 6-11);

receiving from the first user at least one user-selected characteristic associated with media, i.e. the selection of specific media characteristics associated with media, such as that found on a conventional program guide 88A, to be included in viewing preference information to be shared with a 2nd user (col.9, lines 28-32; col.10, lines 25-35; col.12, lines 30-41; col. 15, lines 52-65);

processing a media request from the first user via a communication network, the requested media having a pre-defined set of characteristics, i.e. the selections by a 1<sup>st</sup> user, via a receiver 64, of media programs - whereby each media program selected has characterizing information from the associated program guide (col.10, lines 13-24);

notifying the at least one second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media matches the at least one user-selected characteristic, i.e. the delivery of viewing preference information from a 1<sup>st</sup> user to a 2<sup>nd</sup> user, via telephone lines or the Internet, only if the characterizing information from the associated program guide matches that of the media characteristics chosen by a 1<sup>st</sup> user to be sent to a 2<sup>nd</sup> user and the 2nd user accepts the viewing preference information (col.12, lines 30-45; Col. 13, lines 1-28; col.15, lines 52-65);

refraining from notifying the at least second user, via the communication network, of the consumption of the requested media by the first user, if the pre-defined set of characteristics for the requested media does not match the at least one user-selected characteristic, i.e. the non-transmittal or non-acceptance of the portion of the viewing preference information in which the characterizing information from the associated

program guide does not match that of the media characteristics chosen by a 1<sup>st</sup> user (col.12, lines 30-45; Col. 13, lines 1-28; col.15, lines 52-65).

Finseth does not clearly teach receiving a media request from the first user via a communication network, wherein the media request relates to media to be sent directly via the communication network from a second user to the first user.

Ellis teaches receiving a media request from a first user via a communication network, wherein the media request relates to media to be sent directly via the communication network from a second user to the first user, i.e. a user creates and stores personal programming at the user's set-top box or PC and, in response to a user's request, delivers the media to the requesting user via a dedicated channel (Col. 3, lines 18-30; Col. 5, lines 23-44; Col. 10, lines 9-33). The requesting user selects the media from a program guide (Col. 10, lines 9-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Finseth to include receiving a media request from the first user via a communication network, wherein the media request relates to media to be sent directly via the communication network from a second user to the first user, as taught by Ellis, for the purpose of supporting the creation and distribution of video programming created by individual contributors (Ellis-Col. 1, lines 19-22).

Regarding claim 3, Finseth in view of Ellis teaches wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an

intranet infrastructure, a wired infrastructure, and/or a wired infrastructure, i.e. the transmittal of viewing preference information from a 1<sup>st</sup> user to a 2<sup>nd</sup> user via telephone lines or the Internet (Finseth-col.12, lines 42-45; Ellis-Col. 3, lines 5-18).

Regarding claim 4, Finseth in view of Ellis teaches wherein the communication network is the Internet (Finseth-col.12, lines 42-45; Ellis-Col. 3, lines 5-18).

Regarding claim 5, Finseth in view of Ellis teaches wherein the requested media comprises one or more of audio, a still image, video, real time video, and/or data (Finseth-col.7, lines 19-20 & 54-55; col.10, lines 16-18; Ellis-Col. 10, lines 9-33).

Regarding claim 6, Finseth in view of Ellis teaches wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data (Finseth-Fig.3; col.7, lines 19-27 & 64-67; col.8, lines 49-52; Ellis-Col. 10, lines 9-33).

Regarding claim 7, Finseth in view of Ellis teaches wherein the information identifying at least a second user comprises at least one or more of a legal name, a given name, a screen name, a user identifier, a network identifier, an Internet protocol (IP) address, a media access control (MAC) address, and/or electronic serial number, i.e. the use of a name, telephone number, or internet address in designating a 2<sup>nd</sup> user

to receive viewing preference information from a 1st user (Finseth-Fig.7 & 9; col.12, lines 25-29; col.15, lines 6-11).

Regarding claim 8, Finseth in view of Ellis teaches wherein the at least one user-selected characteristic comprises one or more of a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode and/or a language, i.e. the ability of a 1<sup>st</sup> user to specifically select contents from its history table to be sent to a 2nd user, where contents consist of information such as genre, title keyword, keywords, etc. (Finseth-col.10, lines 25-36; col. 51-65; Ellis-Col. 10, lines 9-33).

Regarding claim 9, Finseth in view of Ellis teaches wherein the notifying comprises transmitting a message via the communication network, i.e. the transmittal of viewing preference information from a 1st user to a 2nd user via telephone lines or the Internet (Finseth-col.12, lines 42-45).

Regarding claim 10, Finseth in view of Ellis teaches keeping a record of the notifying; and the record being used by the second user to provide one or both of services and/or incentives to the first user (Finseth-Col. 11, lines 20-42; Col. 13, lines 1-18), Note: the second user stores the first user's viewing preference information and can subsequently share his/her viewing preference information with the first user which can improve advertising and conditional channel content targeting for the first user.



Claim 11 is met as previously discussed with respect to Claim 1. In addition, Finseth et al. teach the identification of individual users interacting with receiver, 64 (col.11, lines 2-11).

Claim 12 is met as previously discussed with respect to Claim 5.

Claim 13 is met as previously discussed with respect to Claim 8.

Claim 14 is met as previously discussed with respect to Claim 8.

Claim 15 is met as previously discussed with respect to Claim 3.

Claim 24 is met as previously discussed with respect to Claim 1.

Claim 26 is met as previously discussed with respect to Claim 3.

Claim 27 is met as previously discussed with respect to Claim 4.

Claim 28 is met as previously discussed with respect to Claim 5.

Claim 29 is met as previously discussed with respect to Claim 6.

Claim 30 is met as previously discussed with respect to Claim 8.

Claim 31 is met as previously discussed with respect to Claim 9.

Claim 32 is met as previously discussed with respect to Claim 10.

3. Claims 2 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finseth in view of Ellis and further in view of Lu (US 7,065,778).

Regarding claim 2, Finseth in view of Ellis teaches all elements of claim 1.

Finseth in view of Ellis does not clearly teach wherein each of the first user and the at least a second user are associated with one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN).

Lu teaches each of a first user and a second user are associated with one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN) (Col.10, lines 10-15, 31-38).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Finseth in view of Ellis to include each of the first user and the at least a second user are associated with one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN), as taught by Lu, for the purpose of utilizing a well-known and establishing method of identifying a device for communication.

Claim 25 is met as previously discussed with respect to Claim 2.

4. Claims 16-23 and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu in view of Finseth and further in view of Ellis.

Regarding claim 16, Lu teaches the system comprising: a first storage, at a first location, having an associated first network address; a first set top box circuitry at the

first location, the first set top box circuitry communicatively coupled to the first storage to support consumption of media by a first user, i.e. the use of a personalized video recorder (PVR) 200 at a first location, having a usable mass data storage device 218, a display device 212 for displaying video and/or graphics, and an associated IP address (Fig.2 & 3; col.5, lines 26-35; col.6, lines 17-21; col.10, lines 10-15);

a second storage, at a second location, having a second network address; a second set top box circuitry at the second location, the second set top box circuitry communicatively coupled to the second storage to support consumption of media by a second user, i.e. the use of a 2<sup>nd</sup> personalized video recorder (PVR) 200A/B at a second location having similar components as that of PVR 200, as discussed above;

at least one media characteristic associated with the second user, i.e. the association of a second PVR 200A/B with the television shows being broadcasted by a corresponding television content provider, television head-end 308, via an electronic programming guide (Fig.3; col.6, lines 43-54);

server software that receives a request that identifies at least the associated first network address and media having at least one pre-defined characteristic, and that notifies, via a communication network, the associated second network address if the at least one media characteristic matches the at least one pre-defined characteristic, i.e. the use of a PVR 200, having an associated IP address, in requesting a specific television show via an EPG server computer 304, and the subsequent notification to an appropriate PVR 200A/B to which the requested television program will be broadcasted

to in the event the specific requested television show matches the television programs being broadcasted to PVR 200A/B (Fig.3 & 5; col.col.6, lines 32-55; col.9, lines 8-20).

Lu does not clearly teach the first user directly requests media from the second user.

Additionally, in the same field of endeavor, Finseth teaches the transmittal of a plurality of information, via a programming guide, including a program title, channel names, channel numbers, & icons (col.9, lines 28-32; col.10, lines 25-35).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have combined the system taught by Lu with that of the system taught by Finseth in order to provide a suitable manner in which to associate media programs being transmitted to a plurality of users by way of the programming guide information contained within it. A person of ordinary skill in the art would have been motivated to have made such a modification to the Lu et al. reference in order to allow for a more accurate method of determining the media programs being presented to a plurality of users.

Lu in view of Finseth does not clearly teach the first user directly requests media from the second user.

Ellis teaches receiving a direct request, from a first user for media from the second user, i.e. a user creates and stores personal programming at the user's set-top box, PC, PVR, etc and, in response to a user's request, delivers the media to the requesting user via a dedicated channel (Col. 3, lines 18-30; Col. 5, lines 23-44; Col. 10,

lines 9-33). The requesting user selects the media from a program guide (Col. 10, lines 9-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lu in view of Finseth to include server software that receives a direct request, from the first user for media from the second user, as taught by Ellis, for the purpose of supporting the creation and distribution of video programming created by individual contributors (Ellis-Col. 1, lines 19-22).

Regarding claim 17, Lu in view of Finseth in view of Ellis teaches wherein the requested media comprises one or more of audio, a still image, video, real time video, and/or data (Lu-col.7, lines 25-28; col.11, lines 4-7; Finseth-col.7, lines 19-20 & 54-55; col.10, lines 16-18; Ellis-Col. 10, lines 9-33).

Regarding claim 18, Lu in view of Finseth in view of Ellis teaches wherein the associated first and second network addresses are one of an Internet protocol (IP) address, a media access control (MAC) address, or an electronic serial number (ESN) (Lu-col.10, lines 10-15,31-38).

Regarding claim 19, Lu in view of Finseth in view of Ellis teaches wherein consumption comprises one or more of playing audio, displaying a still image, displaying video and/or displaying data (Lu-Fig.2; col.6, lines 21-28; Finseth-Fig.3; col.7, lines 19-27 & 64-67; col.8, lines 49-52; Ellis-Col. 10, lines 9-33).

Regarding claim 20, Lu in view of Finseth in view of Ellis teaches wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure (Lu-col.6, line 62 - col.7, line 8; Finseth-col.12, lines 42-45; Ellis-Col. 3, lines 5-18).

Regarding claim 21, Lu in view of Finseth in view of Ellis teaches wherein the server software is at a location separate from the first location and the second location, i.e. an EPG server 304 at a location separate from the first location, PVR 200 and the second location, PVR 200A/B (Lu-Fig.3; col.6, lines 33-50; Ellis-Col. 10, lines 9-33).

Regarding claim 22, Lu in view of Finseth in view of Ellis teaches wherein the at least one media characteristic comprises one or more of a title keyword, a subject keyword, a genre, an artist, a time period, a media channel type, a mode, and/or a language, i.e. the information included in an EPG, for the media programs being transmitted to a plurality of 2nd users as in the system presented by Lu, can consist of program titles, channel names, channel numbers, channel icons, etc. (Lu-col.9, lines 28-32; Finseth-col.10, lines 25-36; col. 51-65; Ellis-Col. 10, lines 9-33).

Regarding claim 23, Lu in view of Finseth in view of Ellis teaches wherein the at least one predefined characteristic comprises one or more of a title keyword, a subject keyword, a genre, an artist, a time period, a media channel type, a mode, and/or a language, i.e. the information included in an EPG, such as that presented to a first user for the requesting of a specific television program as in the system presented by Lu, can consist of program titles, channel names, channel numbers, channel icons, etc. (Lu-col.9, lines 28-32; Finseth-col.10, lines 25-36; col. 51-65; Ellis-Col. 10, lines 9-33).

Claim 33 is met as previously discussed with respect to Claim 16.

Claim 34 is met as previously discussed with respect to Claim 17.

Claim 35 is met as previously discussed with respect to Claim 19.

Claim 36 is met as previously discussed with respect to Claim 20.

Claim 37 is met as previously discussed with respect to Claim 21.

Claim 38 is met as previously discussed with respect to Claim 22.

#### **(10) Response to Argument**

##### **I. The Proposed Combination of Finseth and Ellis Does Not Render**

##### **Claims 1, 3-15, 24, and 26-32 Unpatentable**

##### **a. The Proposed Combination Does Not Render Claims 1 and 3-10 Unpatentable**

##### **i. Notification Of Consumption Based On A Match**

In response to appellant's arguments that the given references do not teach "Notification Of Consumption Based On A Match", Page 10, line 17, the examiner respectfully disagrees. Finseth teaches a first user is able to select, i.e.

request, media from a programming guide. Attributes from each requested media item are then stored on the first user's receiver. A user is then able to select the types of viewer preference information to share with other users. The viewer preference information includes category descriptors, television program names, etc. The users can also select the types of information they want to receive from other users (Col. 10, lines 13-36; Col. 12, lines 17-45; Col. 13, lines 1-19; Col. 15, lines 51-65). Ellis teaches that a user creates and stores personal programming at the user's set-top box or PC and, in response to a user request, delivers the media to the requesting user via a dedicated channel (Col. 3, lines 18-30; Col. 5, lines 23-44; Col. 10, lines 9-33).

The combination of Finseth and Ellis enables one of ordinary skill in the art to realize a system that allows a first user to request media from a second user by selecting the media from a program guide and the subsequent viewing of the media by the first user. The specific characteristics of the requested media are stored at the first user's receiver. The first user is then able to select particular program characteristics that he/she wishes to share with another user. All stored program characteristics that "match" these user-selected characteristics are transmitted to the second user, thus "notifying" the second user of the consumption of media. The second user is further able to elect to receive only summary information or only specific characteristics related to the television programs, therefore, any characteristics that "match" the selected characteristics of the second user and the information shared by the first user enable the second



user to be notified of the consumption of the media. The second user will not be notified of any viewing by the first user if the first user does not view any of the second user's media, e.g. the user-selected characteristics do not match any of the predefined characteristics, and/or if the second user does not accept the first user's viewing history information.

Appellant states on Page 13, lines 21-22, as well as in multiple other instances, that Finseth indicates that "the user selects which information to send, but not that another subscriber actually requests the information" (emphasis added). Examiner admits that this statement is correct, however, there is nothing in the claims that states the second user has to request any characteristic information from another user. The claims, as written, are broad enough to encompass the situation wherein a first user selects information to share with a second user. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant states on Page 17, lines 3-5, that Finseth does not teach "that delivery of viewing preference information from a first user to a second user is predicated on a match of any kind", the examiner respectfully disagrees. Firstly, the claims do not state that the delivery of the preference information has to be predicated on a match. The claims state the notification of the second user is

based on a match. Regardless, as stated above, the data has to be matched first to selected characteristics by the first user in order to be shared and second, to selected characteristics by the second user in order for the shared information to be received by the second user. As one can see, the data may be matched twice. In both instances the second user will be notified if the data matches or will not be notified if the data does not match.

**ii. Receiving a Media Request From the First User Via a  
Communication Network, Wherein the Media Request  
Relates to Media to be Sent Directly From the Second  
User to the First User**

In response to appellant's arguments that the given references do not teach "Receiving A Media...The First User", Page 18, lines 1-3, the examiner respectfully disagrees. Ellis teaches a personal television programming system in which a contributing user, e.g. second user, is able to create television programming and store it on storage equipment at his/her location (Col. 5, lines 23-44; Col. 6, lines 1-23). A first user is able to request the contributing user's programming at any time by selecting the desired program from a user interface. This requested program is then delivered from the storage equipment located at the contributing user's premises to the viewer (Col. 10, lines 8-34). As it is clearly stated in Col. 10, the first user may request media on demand directly from the second user in which a server is not used to store the media, but

conversely it is stored on the second user's receiver. Therefore, the combination of the references teaches the aforementioned limitation.

**b. The Proposed Combination of Finseth and Ellis Does Not  
Render Independent Claims 11 and 24 Unpatentable**

No particular arguments are presented over and above those previously raised/addressed. Accordingly, the examiner respectfully disagrees that these claims should be found likewise patentable.

**c. The Proposed Combination Does Not Render Claims 10 and 32  
Unpatentable**

In response to appellant's arguments that the given references do not teach "keeping a record...the first user", Page 20, lines 18-20, the examiner respectfully disagrees. Finseth teaches the viewing preference information stored on the user's receiver is used to provide targeted advertisements to the user. When a first user shares viewing information with a second user, the data may be merged with the second user's viewing information, i.e. keeping a record of the notifying (Col. 11, lines 43-53; Col. 13, lines 1-29). This sharing of data provides both users with information of programs they may not normally have watched. Each time the user share data their respective history is updated and the ads each user receives are directly affected. This enables the users to

receive a more targeted advertisement campaign. Therefore, the combination of the references teaches the aforementioned limitation.

**II. The Proposed Combination of Finseth, Ellis, and Lu Does Not Render  
Claims 2 and 25 Unpatentable**

No particular arguments are presented over and above those previously raised/addressed. Accordingly, the examiner respectfully disagrees that these claims should be found likewise patentable.

**III. The Proposed Combination of Finseth, Ellis, and Lu Does Not Render  
Claims 16-23 and 33-38 Unpatentable**

In response to appellant's arguments that the given references do not teach "server software that...one pre-defined characteristic", Page 21, line 21-Page 22, line 3, the examiner respectfully disagrees. Lu teaches a group of PVRs at separate locations that each has an assigned IP address. A user is able to have a particular PVR record a requested media program and once recorded, instructions enable the transmittal of the requested media program back to the user based on a provided IP address. Finseth teaches a first user is able to select, i.e. request, media from a programming guide. Attributes from each requested media item are then stored on the first user's receiver. A user is then able to select the types of viewer preference information to share with other users. The viewer preference information includes category descriptors,

television program names, etc. The users can also select the types of information they want to receive from other users. Ellis teaches that a user creates and stores personal programming at the user's set-top box or PC and, in response to a user request, delivers the media to the requesting user via a dedicated channel.

As stated above, a first user makes a request for media from a second user by selecting the media from a program guide and the subsequent viewing of the media by the first user. The specific characteristics of the requested media are stored at the first user's receiver. The first user is then able to select particular program characteristics that he/she wishes to share with another user. All stored program characteristics that "match" these user-selected characteristics are transmitted to the second user, thus "notifying" the second user of the consumption of media. The second user is further able to select to receive only summary information or only specific characteristics related to the television programs, therefore, any characteristics that "match" the selected characteristics of the second user and the information shared by the first user enable the second user to be notified of the consumption of the media. The second user will not be notified of any viewing by the first user if the first user does not view any of the second user's media, e.g. the user-selected characteristics do not match any of the predefined characteristics, and/or if the second user does not accept the first user's viewing history information. The combination of the references allows one of ordinary skill in the art at the time the

invention was made to realize a system wherein the second user is notified of media consumption by the first user through the use of the user's respective IP addresses and the communication network.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jeremy Duffield/  
Patent Examiner  
Art Unit 2427

04 December 2009

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